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EXAMINER

SHAFFER, ERIC T

ART UNIT PAPER NUMBER

3623

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/524,366

Applicant(s)

GRENCUS ET AL.

Examiner

Eric T. Shaffer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 5 -10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5 -10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to the amendments filed October 9, 2003.

Summary Of Instant Office Action

2. Applicant's arguments, filed May 12, 2003, concerning claims 1, 2 and 5 - 10 in the Office Action mailed February October 9, 2003, have been considered and deemed unpersuasive.
3. Claims 3 and 4 have been cancelled by the applicant and the applicant has added no new claim. Claims 1, 2 and 5 - 10 are pending and are prosecuted in the response set out below. The objection to the vague term "greatest economic benefit" has been removed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2 and 5 - 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US 5,965,858) in view of Graff (US 5,802,501).

As per claims 1 and 6 - 9, Suzuki et al teaches a method and system of optimally demanufacturing a product to recover a largest revenue, said method comprising:

providing said electronic product for demanufacturing, said electronic product having a plurality of parts, wherein each of said parts comprises one or more commodities (column 7, lines 23 - 25, "the discarded televisions to be reused as the restored material are pulverized or

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fragmented in the recycling factories whereupon some of the fragmented materials will be supplied to the manufacturer”);

collecting one or more resale prices for said electronic product or parts (column 14, lines 32 – 35, “Market Information, details of which, i.e., used article information, are illustrated in FIG. 30. Contents: information of market prices of used articles, part demand information, etc.”

collecting one or more resale prices for one or more of said parts respectively (column 42, lines 53 – 55, “The purchase prices of the material dealers are recorded in the material/part-based recycle method database 37 on a material-by-material basis”).

collecting one or more commodity prices for one or more of said commodities respectively (column 42, lines 53 – 55, “The purchase prices of the material dealers are recorded in the material/part-based recycle method database 37 on a material-by-material basis”);

determining if said electronic product contains hazardous materials (column 7, lines 44 - 60), and if so, determining a hazardous materials handling expense where information concerning handling hazardous material contains how to recognize (column 6, lines 24 – 25, “wherein the component parts are classified into following categories or classes 2 to 6”, where class 5 is hazardous materials), how to handle (column 7, lines 45 – 46, “hazardous materials and requiring special treatment will be treated properly by the manufacturer”) and the cost to handle hazardous material (column 7, lines 57 – 58, “the energy-resource-destined material buyer”), where a buyer would contain the prices of items to be bought;

determination of the labor expenses and hazardous materials handling expense of removing electronic parts from computer products, however he does tabulate the “standard

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number of disassembling steps or processes involved hours)” (column 35, lines 23 – 24), where hours can easily be translated into an expense by multiplying the hours by an hourly salary rate.

entering said resale prices for said electronic product, said one or more resale prices for said one or more parts, said one or more commodity prices (column 10, lines 26 – 28, “in the market information database, there are stored information concerning the market prices of the used articles”), said labor expense (column 35, lines 23 - 24, “standard number of disassembling steps or processes involved hours, etc”), and said hazardous materials handling expense (column 6, lines 31 – 34, “component parts containing harmful/hazardous materials/substances and requiring special processing or treatment”), if any into a computer spreadsheet model;

Suzuki et al does not specifically mention creating a computer spreadsheet model that determines the highest revenue value of a commodity in order to determine which parts to remove and sell. It would be obvious to incorporate a computer do this because it would make calculations faster and more accurate to calculate.

Graff teaches a computer model based device (column 11, lines 40 - 43, “ a LOTUS 123 program dedicated to the purpose of this invention”) for finding the highest commodity value of the removed parts or subcomponents of a property (column 3, lines 20 – 22, “it is frequently possible to sell the components of the property for more than the price of that property”) or a part (column 29, lines 58 – 60, “input data characterizing at least one of the two components decomposed from the property”) and for performing a separation that will “maximize profitability of the components” (column 6, lines 25 - 27).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to consider the revenue generated from recovered parts and the cost

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associated with removing said parts in determining which parts to disassemble and recycle from a larger property because this would prevent a recycler from recycling parts that were not cost effective to recover and would provide the highest profit to one in the recycling business.

6. As per claim 2, Suzuki et al teaches the method of claim 1, wherein said resale prices, said commodity prices, said hazardous materials handling expense and said labor expense are provided from a database wherein said database is periodically updated (column 10, lines 31 – 40, “the market information database stores therein the market prices of the used articles for each of the types of the articles so that the market price information can be obtained when the restored article such as the restored televisions are to be recycled as the used article, as can be seen from FIG. 30. Besides, the information concerning the market prices of the used component parts of the article is also stored so that the market prices of the parts can be made available when they are to be recycled as the used parts”) and (column 8, lines 55 – 57, “the recycle method decision processor unit further includes a recycle method decision module which stores therein a recycle processing decision procedure”).

7. As per claim 5, Suzuki et al teaches a “spreadsheet model” (Figures 26 and 28 – 30).

8. As per claim 10, Suzuki et al teaches the computer program product, further comprising a database comprising said resale prices, said commodity prices, said hazardous materials handling expense, and said labor expense, and wherein said database is recorded on said medium (column 42, lines 53 – 55, “The purchase prices of the material dealers are recorded in the material/part-based recycle method database 37 on a material-by-material basis”).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the electronic parts disassembly and recycling reuse aspects of

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the Suzuki invention with the database of market-based prices in the Graff invention because having a price for a component would help determine if it was cost effective for an organization to recycle a part rather than buy a new one. Knowing the market-based price of a component would help in the buy new or recycle decision by allowing the user to know how much a recycled part would cost in order to consider obtaining used before buying new.

Response to Amendments

9. Applicant's arguments filed October 16, 2003 have been fully considered, but the same are not persuasive.

a) Applicant argues that the Graff reference is not in the field of the applicant's endeavor. However, Graff demonstrates that the concept of taking something apart and selling the individual pieces is old and very well known in many fields of endeavor. It is Suzuki that teaches the individual aspects of taking apart electronic equipment including hazardous materials. The Graff invention teaches taking apart an asset and further selling the individual disassembled pieces in order to demonstrate that it would be obvious to place this type of data into a database and use a computer operable device to determine the cost effectiveness and profitability of disassembly.

b) Applicant argues that Suzuki does not teach executing a computer or spreadsheet model to optimally determine the profitability of a disassembled part. However the Graff prior art does in fact teach providing the greatest economic benefit by disassembling a larger property into component parts in order to "maximize profitability of the components" (column 6, lines 25

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- 27) and using a “computer to produce financial documents from the financial analysis and model documents stored in the memory” (column 6, lines 13 - 15).

In light of the above stated facts, examiner respectfully states that applicant’s arguments have been fully considered, deemed unpersuasive, and the rejections under the prior Office Action, mailed June 19, 2003, are maintained.

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Conclusion

10. THIS ACTION IS MADE FINAL. See MPEM 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 1.136(a). The prior art made record of and not relied upon is considered pertinent to applicant's disclosure.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of final action.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric Shaffer whose telephone number is (703) 305-5283. The Examiner can normally be reached on Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax number for the organization is (703) 305-0040/308-6306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 305-3900.

Eric Shaffer

January 2, 2004

Romain Janty
Primary Examiner
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